



#28/Letter
T.H. = Beth. Brown
11/1/99

PATENTS
112007-0008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re The Application of:)
Michael A. Cleron et al.)
Serial No.: 08/435,377)
Filed: May 5, 1995)
For: EXTENSIBLE REPLACEABLE)
NETWORK COMPONENT SYS-)
TEM)

Examiner: Caldwell, P.

Art Unit: 2755

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Cesari and McKenna, LLP
30 Rowes Wharf
Boston, MA 02110
October 27, 1999

CERTIFICATE OF EXPRESS MAILING

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I hereby certify that the following Communication, Continued Prosecution Application (CPA) Request Transmittal, check in the amount of \$760.00 and Declaration By Assignee Under 37 C.F.R. § 1.31 are being deposited with the United States Postal Service “Express Mail Post Office to Addressee” service pursuant to 37 C.F.R. §1.10 in an envelope addressed to the Assistant Commissioner for Patents, Box CPA, Washington, D.C. 20231, on October 27, 1999.

Honorable Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

COMMUNICATION

These remarks are being submitted together with a Continued Prosecution Application (CPA) in the above-referenced matter. The parent application was finally rejected in an Office Action mailed April 27, 1999.

In the Final Office Action claims 1-5, 7-15 and 17-20 were rejected under 35 U.S.C. §103 in view of U.S. Patent No. 5,584,035 to Duggan et al. (hereinafter "Duggan") in view of H. Norr, *Cyberdog Could Be A Breakthrough If It's Kept On A Leash* MacWeek, Vol. 8, No. 45, p. 50 (Nov. 14, 1994) (hereinafter "Norr"). Claims 6 and 16 were rejected under §103 based on Duggan, Norr and Harkey et al. *Object Component Suites: The Whole Is Greater Than The Parts* Datamation, Vol 41, No. 3, p. 44 (Feb. 15, 1995).

Applicants also submit a Declaration By Assignee Under 37 C.F.R. §1.131 swearing behind the Norr reference and thereby placing all claims in condition for allowance. The Declaration was executed by Ms. Sari Harrison an Engineering Manager at Apple Computer, Inc., which is the assignee of the application as provided in an Assignment recorded at Reel 7509, Frame 0853. As set forth in the Declaration, Ms. Harrison has personal knowledge of the completion of the invention in the United States prior to the date of the Norr reference.

In view of the Examiner's position that a Rule 1.131 Declaration must also satisfy the provisions of M.P.E.P. §201.03, which deal, not with Rule 131 Declarations, but with obtaining the written Consent of Assignee for purposes of changing inventorship, Ms. Harrison explicitly avers at ¶2 that she is authorized to submit the Declaration on behalf of the assignee as suggested in M.P.E.P. §201.03 (the authority of the person signing the consent "should be set forth in the written consent"). The Declaration has also been co-executed by Mr. Albert P. Cefalo, who is the Assistant Secretary at Apple Computer, Inc.,

thereby satisfying the other provision of M.P.E.P. §201.03, which provides that the consent by assignee may be signed by the corporate “president, vice president, secretary, or treasurer.”

As averred at ¶3 of the Declaration, Ms. Harrison has reviewed and is familiar with the claims currently pending in this application. The Declaration, at ¶¶4-6, further sets forth facts showing that the claimed invention was completed in the United States prior to November 1994, which is the date of the Norr reference. In addition, the facts recited in the Declaration are further supported in the form of exhibits as recommended by M.P.E.P. §715.07. For example, attached as Exhibit A to the Declaration is a copy of an Engineering Requirements Specification (ERS) document that supports completion of the invention of independent claims 1, 7 and 17, among others, prior to the date of the Norr reference. Exhibits B and C to the Declaration are a Class Description Document and a Usability Testing document, respectively, each of which pre-dates the Norr reference and demonstrates completion of the invention as recited in claims 2-6, among others.

Based on the facts presented in the Declaration, including the Exhibits attached thereto, applicants submit that the present invention was reduced to practice in this country prior to November 1994, which is the date of the Norr reference. Therefore, pursuant to 37 C.F.R. §1.131, the Norr reference is no longer a bar to the grant of a patent on this application. Since all of the rejections are based, at least in part, on Norr, the removal of Norr as a reference renders the claims in condition for allowance.

Applicants submit that the application is in condition for allowance and early favorable action is requested.

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,



Michael R. Reinemann
Reg. No. 38,280
CESARI AND MCKENNA, LLP
30 Rowes Wharf
Boston, MA 02110-2699
(617) 951-2500